

REMARKS

Claims 1-36 and 42-51 are pending in the application. Claims 1-23, 32-36 and 42-46 have been withdrawn from consideration. Claim 24-31 and claims 47-51 stand rejected under 35 U.S.C. 112 based on editorial errors pointed out by the Examiner in claims 24, 27, 29, 47 and 50. Claims 24-31 and 47-51 also stand rejected under 35 U.S.C. 102(e) as being anticipated by Lamarque III et al., United States Patent No. 6,690,651 (Lamarque). Other prior art is made of record but not relied on.

1. Rejection of Claims 24-31 and 47-51 under 35 U.S.C. § 112, 2nd Paragraph

The Official Action states that claims 24-31 and 47-51 are rejected under 35 U.S.C. § 112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. Applicant respectfully traverses this rejection.

Applicant thanks the Examiner for her suggestions regarding the claims. Accordingly, Applicant has amended the claims in accordance with the Examiner's suggestions to overcome the rejections under 35 U.S.C. 112. More specifically, Applicant has made the changes suggested by the Examiner in claims 25 and 29, line 5, claim 27 and claim 50. Applicant has additionally amended claim 51 in the same manner as claim 50.

Further, claim 29, line 9 has been clarified in response to the Examiner's rejection to clarify the distinction between the first data packets recited at lines 5-

8 and the second data packets to be transmitted after the evaluation takes place, recited at lines 9-10.

Regarding claim 47, the phrase “said test packets” has been corrected to recite “said path characteristic packets” to agree with its antecedent and provide a proper antecedent for claims 49 and 50. This recitation is supported at page 23, lines 15-17, where applicant states that the M/R system continually monitors the characteristics of the various paths between interfaces. The phrase “path characteristic packets” appears at page 22, line 20.

Accordingly, Applicant respectfully request the Examiner to reconsider and withdraw the rejection of presently pending claims 24-31 and 47-51.

2. Rejection of Claims 24-31 and 47-51 under 35 U.S.C. § 102(e)

The Official Action states that claims 24-31 and 47-51 are rejected under 35 U.S.C. § 102(e) as anticipated by Lamarque, III et al., U.S. 6,690,651. Applicant respectfully traverses this rejection.

The test for anticipation is whether each and every element as set forth is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131. The elements must also be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

The presently claimed invention relates to methods and systems for providing at least one of two communication paths within a digital network. In particular, Applicant discloses and claims a method and system for transmitting packets in a computer network. Typical embodiments of such systems use a voice over intellectual property (VOIP) protocol. If the packet transmission from a first location to a second location in a computer network is not accomplished in a defined desired manner initially, then Applicant's system transmits from the first location to a third location and from the third location to the second location in the computer network. Consequently, packet transmission is achieved. These recitations are included in each of the presently pending independent claims, claims 24, 29 and 47.

In contrast, paragraph 4 of the present Official Action refers to Lamarque's teachings at column 1, line 60 - column 2, line 7, column 3, lines 52-60, column 4, lines 17-20 and column 8, lines 12-22. The initial cited passage states, "Responsive to quality of service of the voice call failing to meet a quality of service threshold in the packet based network, a signal is sent to the user to see if the routing of the voice call should be changed to another path. ...

Alternatively, the call may be automatically rerouted to another path ... in the packet based network." Accordingly, Lamarque is directed to rerouting. However, rerouting alone does not anticipate Applicant's presently pending claims. It is further submitted that one skilled in the art cannot arrive at Applicant's claimed method and system solely by reading Lamarque's specification and the remaining cited passages in particular.

In particular, Lamarque refers to two forms of changing the routing in sending a call from an end user PC 124 to an end user PC 134 (Fig. 1 and column 3, lines 39-46). The call is initially sent over a path 142. (Column 3, lines 43-46) Path 142 is a packet-based network comprising local area networks, LANs 106 and 108, and a wide area network, WAN 104, coupled between the LANs 106 and 108. The local area networks are packet-based networks and together comprise a packet-based network.

At column 3, lines 51-63, Lamarque refers to a first form of rerouting calls when the quality of service on a packet-based network becomes unacceptable. Lamarque teaches switching the call to a path 144 (line 60). The path 144 includes PSTN 102. At column 3, lines 3 and 4, Lamarque specifically points out that PSTN 102 is a switched network. Lamarque's PSTN 102 by definition is inoperative to transmit data packets. In contrast, Applicant has specifically recited transmitting data packets in the presently pending claims. Also, Applicant explicitly recites that the first and second locations are on a computer network and that the third location through which a call is routed is on the computer network. This disclosure of Lamarque does not include a first, second and third locations on a computer network. It is therefore submitted that this teaching of Lamarque cannot anticipate any of Applicant's claims since Lamarque does not disclose each and every limitation of the presently pending claims, as required by *Verdegaal Brothers v. Union Oil Co. of California*. Accordingly, this teaching of Lamarque does not serve as a basis for a rejection under 35 U.S.C. 102(e).

Further, the rejection of paragraph 4 refers to a second form of rerouting alluded to by Lamarque. The rejection of paragraph 4 further states that Lamarque teaches that a call is rerouted to take a different path on the packet based network. The Examiner cites column 4 and column 8 of Lamarque in this regard. At column 4, lines 17-23, Lamarque states:

The calls may be transferred or rerouted in a number of ways. For example, the path may be to another path having a higher quality of service on the packet based network or to a path through a legacy telephone environment.

Column 8, at lines 12-22, further refers to a message flow diagram for transferring a call from one packet based network path to another packet based network path. An anticipation rejection is made on the basis that, "The call taking a different path inherently covers the action of transmitting packets to a third location before transmitting them to the destination." Applicant respectfully traverses this assertion. It is respectfully submitted that inherency is not made out under the criteria of the MPEP.

Criteria for Inherency Under the MPEP

MPEP 2112 addresses requirements of a rejection based on inherency.

At page 2100-55, the Manual states:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)

It is submitted that Lamarque does not provide a factual basis in fact or technical reasoning on which to base a conclusion that he discloses a packet switched path going to an intermediate third location. In particular, Lamarque merely mentions a "transfer to directory number" and routing digits at column 8, lines 19 and 20. As such, Lamarque could simply send his call over a different telephone number in the same network. Further, the interfaces within the WAN 104 are not disclosed by Lamarque to change; there is no mention of going to a third location. Lamarque may simply use a different telephone number and still connect between exactly the same first and second interfaces as the rerouted call was originally connected to. Lamarque's alternate paths could simply be parallel redundant paths between the same first and second locations.

Lamarque does not in any way mention a third location, as required by the presently pending claims.

Assuming *arguendo* that Lamarque's words could be used in a manner consistent with Applicant's recitations, this still does not show that Applicant's structure would necessarily result from Lamarque's description. It is at best a possibility. However, the MPEP requires that the claimed structure must necessarily be indicated by the reference. Accordingly, it is submitted that withdrawal of the rejection under 35 U.S.C. 102(e) is warranted for this reason.

The MPEP Requirement of Disclosure to Support Inherency

It is further noted that Lamarque's disclosure could not support a claim to what Applicant has recited. MPEP 2181, at page 2100-224 states, "If there is no

disclosure of structure, material or acts for performing the recited function, the claim fails to satisfy the requirements of 35 U.S.C. 112, second paragraph.

Budde v. Harley-Davidson, Inc., 250 F.3d 1369, 1376, 58 USPQ2d 1801, 1806 (Fed. Cir. 2001)."

Lamarque's only specific teaching of rerouting appears at column 8, lines 30-34, with respect to analog calls. The rerouting is done with analog components such as the PSTN 102 or telephone switch 110 or 112. Lamarque makes no disclosure of another packet based network path. For rerouting packet-based calls, at lines 27-29 of column 8, Lamarque refers to a new path in the packet-based network. No components or path are described that will comprise the new path. No third location, as recited by Applicant, is shown in the specification or drawings. It is submitted that Lamarque's inability to support a claim under the standards of MPEP 2181 further indicates that Applicant's recited structure is not inherently disclosed.

Use of Applicant's Teachings

While the present rejection is based on anticipation and not on obviousness, the rejection relies on finding suggested teachings in a prior art reference. MPEP 2142, in discussing criteria for obviousness, points out that the suggestion to arrive at Applicant's claimed combination must be found in the prior art. It is not permissible to use the teachings of Applicant's disclosure. The recitation of existence of a third location located between the first and second locations through which packets are routed is found only in Applicant's claims and specification. Finding first, second and third locations in Lamarque can only be done starting from

a reading of Applicant's claims and then using Applicant's claims as a checklist. Applicant has specifically defined locations in the specification as geographic locations. Applicant illustrates locations as being separate geographical locations. Each interface, e.g., an interface 360, 376 or 384 specified at page 23 of the specification and as illustrated in Figure 5, is in separate geographical locations. Lamarque, in Figure 1, discloses only the WAN 104 for routing over distances and does not describe any locations within the WAN 104. It is therefore submitted that Lamarque cannot independently support the present rejection.

The Dependent Claims

Applicant submits that the dependent claims distinguish over the art of record by virtue of their dependence from the independent claims and by virtue of their further recitations.

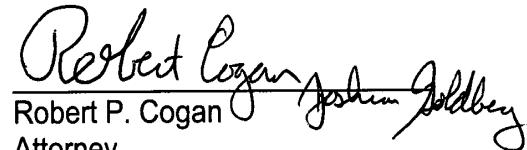
Accordingly, applicants respectfully request the Examiner to reconsider and withdraw the rejection of presently pending claims 24-31 and 47-51.

CONCLUSION

In light of the foregoing, Applicant has demonstrated that claimed recitations are not disclosed directly or inherently in the art of record and that withdrawal of the rejection under 35 U.S.C. 102(e) is warranted. For the reasons pointed out above, it is believed that this application is in condition for allowance and such action is respectfully solicited. The Examiner is therefore respectfully requested to reconsider

and withdraw the rejections of all pending claims 24-31 and 47-51 and allow these claims. If there remain any issues to be discussed, Examiner Jung is invited to telephone the undersigned attorney.

Respectfully submitted,


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